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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,519	07/03/2001	Dale Francis Obeshaw	DP-300393	7536

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EXAMINER

ZIMMERMAN, JOHN J

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/898,519

Applicant(s)

OBESHAW, DALE FRANCIS

Examiner

John J. Zimmerman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-31, 33, 34, 36-38 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-31, 33, 34, 36-38 and 40-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## FOURTH OFFICE ACTION

### *Amendments*

1. This Office Action is in response to the Amendment and Request for Reconsideration received December 1, 2003. Claims 1-15, 17-31, 33-34, 36-38 and 40-42 are pending in this application.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-15, 17-31, 33-34, 36-38 and 40-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,586,110 in view of applicant's disclosure of the prior art. Although the conflicting

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claims are not identical, they are not patentably distinct from each other because the claims of the patent and the claims of this application both claim a contoured structural member having a continuous plurality of contoured metal-containing layers in an inner section and an outer section and further having and an intermediate section of a ribbed (e.g. honeycomb) structure. Although it is noted that the claims of this application now recite "a structural component", each section of the contoured structural members of the claims of the patent and the claims of this application qualify as a "structural component" and therefore there is no patentable distinction in this limitation. In any event, since the contoured structural members of the two sets of claims are designed as parts to be incorporated into other components, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add structural components to the contoured structural members to attach them or incorporate them into other larger structures. Indeed, applicant's description of the related art in the "Background of the Invention" section of the specification (see the figures in the cited patents) shows that the this adding structural components is typical in the relevant art. One must consider the level of ordinary skill in the relevant art when evaluating obviousness. It is axiomatic that consideration of the prior art cited by the examiner must, of necessity, include consideration of the admitted state of the art found in applicant's specification, *In re Davis*, 305 F.2d 501, 134 USPQ 256 (CCPA 1962); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). Admitted knowledge in the prior art may be used in determining patentability of the claimed subject matter, *In re Nomiya*, 509 F.2d 566, 184 USPQ 607 (CCPA 1975).

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4. Claims 1-15, 17-31, 33-34, 36-38 and 40-42 are provisionally rejected under the judicially created doctrine of obviousness type double patenting over claims 1-39 of copending Application No. 09/900,762 in view of applicant's disclosed prior art. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of both applications claim a contoured structural member having a continuous plurality of contoured metal-containing layers in an inner section and an outer section and further having and an intermediate section of a ribbed structure. Although it is noted that the claims of this application now recite "a structural component", each section of the contoured structural members of the claims of both applications qualify as a "structural component" and therefore there is no patentable distinction in this limitation. In any event, some claims (e.g. claim 17) of the copending application specify further structural components. In any event, since the contoured structural members of the two sets of claims are designed as parts to be incorporated into other components, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add structural components to the contoured structural members to attach them or incorporate them into other larger structures. Although it is noted that some claims of the copending application require that the structural member be in a "substantially non-straight" configuration, in view of the fact that the structural members of the copending application and this application are designed to be parts of larger structures, it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the structures in non-straight configurations. In the particular art to which applicant's structures belong, applicant discloses various examples (see Background of the Invention, pages 2-4; e.g. U.S. 5,848,767; U.S. 5,652,039; U.S. 5,195,779; U.S. 5,140,913, etc. . .) of typical structures and

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uses. These structures clearly show that conventional structures in the relevant prior art are indeed typically configured in non-straight configurations. The structures of the disclosed relevant prior art also confirm that adding further structural components is conventional practice. Therefore, this further provides evidence of the level of ordinary skill in the art at the time the invention was made and also provides support for the position that using non-straight configurations would be considered an obvious alternative form for structures of the types claimed and would not be considered separate or patentably distinct inventions. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-15, 17-31, 33-34, 36-38 and 40-42 are provisionally rejected under the judicially created doctrine of obviousness type double patenting over claims 1-38 of copending Application No. 09/899,320 in view of applicant's disclosure of the prior art. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of both applications claim a contoured structural member having a continuous plurality of contoured metal-containing layers in an inner section and an outer section and further having and an intermediate section of a ribbed structure. Although it is noted that the claims of this application recite "a structural component", each section of the contoured structural members of the claims of both applications qualify as a "structural component" and therefore there is no patentable distinction in this limitation. In any event, since the contoured structural members of the two sets of claims are designed as parts to be incorporated into other components, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add

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structural components to the contoured structural members to attach them or incorporate them into other larger structures. Indeed, applicant's description of the related art in the "Background of the Invention" section of the specification (see the figures in the cited patents) shows that the this adding structural components is typical in the relevant art. One must consider the level of ordinary skill in the relevant art when evaluating obviousness. Regarding the issue that claims of the copending application recite "a coating", the examiner notes that coatings (e.g. painting, corrosion proofing, wear proofing, improving aesthetics) are typically applied to structural members and there is no patentable distinction in simply applying coatings to the contoured structural members. It would have been obvious to one ordinary skill in the art at time the invention was made to apply a coating to the structural member of the claims of this application (e.g. for aesthetics, corrosion resistance, weather proofing, etc. . .). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

6. Applicant's arguments filed December 1, 2003 have been fully considered but they are not persuasive with regards to the remaining rejections.

7. Regarding the rejection of claims 1-15, 17-31, 33-34, 36-38 and 40-42 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,586,110 and applicant's copending applications, applicant argues that the examiner has "mischaracterized what the pending claims recite" and "the claims must be read

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in light of the specification". The examiner notes that limitations in the specification are not read into the claims and the interpretation by the examiner clearly falls within the ordinary usage of the terms by one of ordinary skill in the art. See MPEP 2111. Indeed, the section of the specification cited by the applicant (pages 38-39) merely gives some examples of additional structures and does not limit the "structural component" to only those examples or similar types of structures in any way. The Patent and Trademark Office gives verbiage of claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification. The applicant's disclosure contains no definition or other instructions for interpretation of the term "structural component" for the purposes of the claimed invention and therefore the term was given its broadest reasonable interpretation in the rejections.

8. In view of the new rejections, this Office Action has not been made Final.


### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Zimmerman  
Primary Examiner  
Art Unit 1775

jjz  
April 29, 2004